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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,222	05/09/2001	Roger Alcaly	3109/1G960 US1	4229

7590 08/26/2004  
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New York, NY 10022

EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/852,222

Applicant(s)

ALCALY ET AL.

Examiner

Daniel S Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08/31/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. The invention in the body of the claim is not tied to technological art environment or machine, the claim is not statutory. The recitation in the body of claims 1, 3, 14, 20, 22, 24 are directed to merely human mental computation and/or processes that can be performed by a person manually, and this is considered nothing more than an abstract idea which is not a useful art as contemplated by the constitution [see Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD Pat. App & Inter 2001) (Unpub)]\*. Also note MPEP 2106 IV(b). The abstract idea does not become technological art the recitation of the invention in the body of claim manipulates an abstract idea without producing a useful, concrete and tangible result.

\*Even though Bowman is not precedential, it can be cited for its analysis.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melnikoff (US 5,784,696) in view of Champion et al (US 5,126,936)

Melnikoff discloses, as in claims 1, 3, 9, 14, 22, 24, 27 a method and apparatus for generating an index of investment returns comprising steps of: selecting a representative set of assets, where said assets may be grouped into a plurality of assets (see Melnikoff, Abstract); and computing the index as a function of the returns for each class (see Melnikoff, Abstract, col. 11, ll. 17+),

as also in claims 9, 16, 17, 25, 26, determining a plurality of holding periods 182 (see Melnikoff, fig. 5C)

Re claims 2, 4, 15, 21, 23: computing index further comprises the step of selecting weights such that each weight corresponds to one of said plurality of classes, and averaging the products of the return for each class multiplied by its corresponding weight (see Melnikoff, fig. 5C),

Re claim 5, selecting at least one asset from each of two commercial markets (see Melnikoff, col. 7, ll. 29+), wherein the group of assets comprises at least one

Re claims 28-33: a computer-readable medium encoded with processing instructions to performing the method of the aforementioned claims above (see Melnikoff, figs. 11 and 12, col. 7, ll. 15-25; col. 21, ll. 48+)

Melnikoff fails disclose as in claims 1, 3, 7-9, 14, 27, generating a rule to determine the *position* of for each asset for time t, determining the position for each of said assets for said time t, determining a market price for each of said assets for said time t (see Melnikoff, Abstract), computing a return for each of said assets for said time t, said return being a function of the position and the market price determined in steps (c) and (d) (see Melnikoff, Abstract), averaging the returns computed in step (e) for all the selected assets in each of said plurality of classes, the average of each of said classes is the return for that class. This is disclosed by Champion (see col. 3, ll. 8+). It would have been obvious for an artisan to modify Melnikoff with the aforementioned features disclosed in Champion to alternatively evaluate and manage asset portfolios based upon long and short positions expressed in Champion to accurately direct and adjust the level of portfolio risk. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF  
August 20, 2004



Daniel S Felten  
Examiner  
Art Unit 3624

**VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
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